

REMARKS

Claims 2-11 were pending in the application before this Office Action. Claims 2-11 have been canceled and claims 12-19 have been added in this response. Claims 12-19 are pending.

All amendments are made in a good faith effort to advance the prosecution on the merits. Applicants reserve the right to subsequently take up prosecution on the claims as originally filed in this or appropriate continuation, continuation-in-part and /or divisional applications.

Rejections under § 101 - Double Patenting

Claims 2 and 7 were rejected under 35 U.S.C. § 101 for double patenting. Claims 2 and 7 have been canceled.

Rejections under § 112

Claims 8-11 were rejected under § 112 due to insufficient antecedent basis of the limitation “said instruction set.” New claims 16-19 included the limitations of canceled claims 8-11 and an additional limitation to provide antecedent basis for the limitation “said instruction set.”

Rejections under § 101 - Statutory Subject Matter

Claims 3-6 and 8-11 were rejected under § 101 for being directed to non-statutory subject matter. The limitation of canceled claims 3-6 and 8-11 are included in new claims 12-15 and 16-19, respectively. Canceled claims 3-6 and 8-11 depended from claims 2 and 7, respectively, which were directed to microcontrollers. Likewise, new claims 12-19 are directed to microcontrollers and are statutory subject matter.

The Office Action states that:

The independent claims although part of the dependent claims and set forth an apparatus, are not the inventive concept in the dependent claims. The particular encoding of data is the inventive

concept in the dependent claim. The particular encoding of a set bits is an abstract idea and not statutory.

Office Action, page 3.

Applicants disagree. First, Applicants object to any characterization of the point of novelty of the claims. Second, Applicants note that there is no citation to any statute or case for the Office Action's discussion of the "inventive concept in the . . . claims." Applicants assert that this is based on a misapprehension of law. The Supreme Court has stated: "In determining the eligibility of respondents' claimed process for patent protection under § 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of old elements in the analysis." *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981). Claims 12-19 when considered **as a whole** are directed to microcontrollers and are therefore statutory subject matter.

SUMMARY

Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone or facsimile.

Applicants believe that no fees are due at this time. If the Commissioner deems any additional fee is due, the Commissioner is hereby requested to accept this as a Petition therefore, and is authorized to charge any fees due, including any fees for an extension of time, to Baker Botts L.L.P. (formerly, Baker & Botts, L.L.P.) Deposit Account number 02-0383, Order number 068354.1411.

Respectfully submitted,

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